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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,463	09/29/2003	Hidehiko Fujiwara	Q77726	7948
23373 7590 02/01/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER SHAN, APRIL YING	
			ART UNIT 2135	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/01/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/671,463

Applicant(s)

FUJIWARA ET AL.

Examiner

April Y. Shan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/29/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-32 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application, with application number 326657/2002 filed in Japan on 11 November 2002.

Specification

3. The abstract of the disclosure is objected to because the first sentence is grammatically incomprehensible.

Correction is required. See MPEP § 608.01(b).

Please fix any informality the Applicant is aware of.

Claim Objections

4. Claims 1-3, 5-19 and 21-32 are objected to because of the following informalities:
 - a. In claim 1, the sentence "wherein service classes each for each...are preset" is grammatically incomprehensible;
 - b. In claim 9, "the number of times...as points" should be "wherein the number of times...as points".

Any claim not specifically addressed, above, is being objected as incorporating the deficiencies of a claim upon which it depends.

Please check the claims and correct any informality the Applicant is aware of.
Appropriate correction is required.

5. Claims 24-26 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

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Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Accordingly, claim 24 is further treated on the merits depending on Examiner's best understanding on claim 24 is a dependent claim of claim 23.

Any claim not specifically addressed, above, is being objected as incorporating the deficiencies of a claim upon which it depends. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

8. Claims 6, 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **claim 6**, it recites "the ISP based on advertisements", lacks of an antecedent basis.

As per **claim 24**, it recites the limitation depending on "claim 24". How can a dependent claim depend on itself?

Accordingly, claim 24 is further treated on the merits depending on Examiner's best understanding on claim 24 is a dependent claim of claim 23.

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Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon which it depends. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-7, 15-23 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by the Applicant's admitted prior art by Jun (Japanese Patent Laid-open 2001-266018. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office)

As per **claim 1**, Jun discloses an internet connection service providing method, wherein service classes each for each user as a subject of authentication of log-in in network are preset ("...Vender Q set up beforehand the content of the service offered for every customer ID..." – e.g. paragraph [0032]), a service class preset for a logged-in user is recognized ("...which is transmitted in addition to this, and holds it, and every which this connects..." – e.g. paragraph [0032]), and a service corresponding to a recognized service class to a pertinent user based on the recognition is provided ("...customer P is provided with the content of service..." – e.g. paragraph [0032]).

As per **claim 2**, Jun discloses a method as applied above in claim 1. Jun further discloses wherein a fee corresponding to the service class is computed based on fee managing data and charged to the pertinent user (e.g. paragraph [0005], [0010]).

As per **claim 3**, Jun discloses a method as applied above in claim 1. Jun further discloses wherein an applicable service class is preset for each user on the basis of a contract (e.g. abstract).

As per **claims 4 and 20**, Jun discloses an internet connection service providing method, wherein a particular ISP (internet service provider) (paragraph [0059]) provides an internet connection service in a plurality of places ("outside a metaphor house" – e.g. paragraph [0059]), and user management data concerning service classes preset for individual users and service class correspondence data representing service contents corresponding to the service classes are provided as a system in the ISP (e.g. paragraph [0059]), and a service corresponding to each user utilizing the internet connection service is provided (e.g. paragraph [0059]), as desired, based on the user management data and the service class correspondence data irrespective of connection from any one of the plurality of places (e.g. paragraph [0059]).

As per **claim 5**, Jun discloses a method as applied above in claim 1. Jun further discloses wherein advertisement data which have been preliminarily received from an

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advertisement requester and accumulated are distributed to logged-in users in correspondence to pertinent service classes (e.g. paragraph [0030]).

As per **claim 6**, Jun discloses a method as applied above in claim 5. Jun further discloses wherein utilization or communication service fees concerning the distribution of the advertisement data to the pertinent users are covered by advertisement fee paid by the advertisement requester to the ISP based on advertisements as the subject of the request (e.g. paragraph [0031]).

As per **claim 7**, Jun discloses a method as applied above in claim 1. Jun further discloses wherein the advertisement data preliminarily received from the advertisement requester and accumulated are further distributed to the pertinent users based on advertisement distribution requests therefrom (e.g. paragraph [0050], [0055]).

As per **claim 15**, Jun discloses a method as applied above in claim 1. Jun further discloses wherein the service classes of the logged-in users are recognized (e.g. "...which is transmitted in addition to this, and holds it, and every which this connects..." – e.g. paragraph [0032]), and services classified by predetermined communication qualities are provided to users (e.g. paragraph [0028]).

As per **claim 16**, Jun discloses a method as applied above in claim 1. Jun further discloses wherein the service classes of the logged-in users are recognized (e.g.

paragraph [0032]), and services classified based on the kinds of preset accessible media and protocol are provided to users in correspondence to recognized service classes (e.g. paragraph [0028]).

As per **claims 17 and 18**, Jun discloses an internet connection service system applicable for carrying out the method as set forth in claim 1, comprising a network managing server for managing the network utilization state of each of a plurality of users (e.g. paragraph [0032]), a router for connecting the system to internet (e.g. paragraph [0030]), and a service server (e.g. paragraph [0031]), the service server being arranged to provide services and charge fees to the users based on service class data for managing service classes capable of being utilized by the users and fee management data for managing the state of fee charging for each user and wherein the fee management data constitutes the basis of charging a fee corresponding to the service class of each user (e.g. paragraph [0031]).

As per **claim 19**, Jun discloses an internet connection service system according to claim 1, wherein the service class data are built up by preliminarily setting, by contracts, service classes each applicable to each user (e.g. abstract and paragraph [0032]).

As per **claims 21-23**, Jun discloses an internet connection service system according to claim 17, which further comprises an advertisement distributing server for

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accumulating advertisement data preliminarily received from advertisement requester and distributing the accumulated advertisement data to the users (e.g. paragraph [0050]), the advertisement distributing server being applicable to distribute advertisement data to pertinent logged-in users corresponding to service classes recognized by data in the service server (e.g. paragraph [0050]), wherein the service server is arranged such as not to charge any fee for advertisement distribution and communication services required therefor to users (e.g. paragraph [0050]), wherein the service server includes a service class correspondence table for managing the service classes such as to fit advertisement distribution requests each from each user and a fee managing table for managing fees for each user (e.g. paragraph [0031] and [0050]), and distributes advertisement data received from the advertisement requester and accumulated to the pertinent users based on the service class correspondence table to meet the user's advertisement distribution requests (e.g. paragraph [0050]).

As per **claim 32**, Jun discloses a system as applied above in claim 21. Jun further discloses comprises an access control unit for limiting communication media according to preset sections provided for the user's service classes, respectively, and the service server includes a media managing table, in which an accessible media and a protocol are defined for each service class (e.g. paragraph [0028]).

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Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 8-14 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over by the Applicant's admitted prior art by Jun (Japanese Patent Laid-

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open 2001-266018. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office)

As per **claim 8**, Jun discloses a method as applied above in claim 7.

Jun does not disclose expressly wherein an amount obtained by subtracting an advertisement reading fee corresponding to the number of times and frequency of advertisement reading from the internet connection service fee is charged. However, Jun discloses in the abstract "The information management center frees users from a portion charged to them of the charge for the internet connection under prescribed conditions" and in the paragraph [0004], Jun discloses "...it is no charge or an Internet access service can be received cheaply and easily. For a vendor while increasing an opportunity to supply the advertisement of own goods to a customer...".

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made that prescribed conditions includes subtracting an advertisement reading fee corresponding to the number of times and frequency of advertisement reading from the internet connection service fee is charged. The motivation of doing so would have been "for a customer even if it is outside a metaphor house, it is no charge or an Internet access service can be received cheaply and easily. For a vendor while increasing an opportunity to supply the advertisement of own goods to a customer", as taught by Jun (paragraph [0004]).

As per **claim 9**, Jun discloses a method as applied above in claim 8.

Jun does not disclose expressly wherein the number of times of advertisement reading as the basis of discount computation or a value obtained by multiplying the number by a coefficient or a numerical value corresponding to frequency or degree is accumulated and updated as points. However, Jun discloses in the abstract "The information management center frees users from a portion charged to them of the charge for the internet connection under prescribed conditions", in the paragraph [0004], Jun discloses "...it is no charge or an Internet access service can be received cheaply and easily. For a vendor while increasing an opportunity to supply the advertisement of own goods to a customer..." and Jun discloses in the paragraph [0032], "...unites the member point balance given to Customer P as a privilege in the purchase..."

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to include the number of times of advertisement reading as the basis of discount computation or a value obtained by multiplying the number by a coefficient or a numerical value corresponding to frequency or degree is accumulated in the prescribed conditions. The motivation of doing so would have been "for a customer even if it is outside a metaphor house, it is no charge or an Internet access service can be received cheaply and easily. For a vendor while increasing an opportunity to supply the advertisement of own goods to a customer", as taught by Jun (paragraph [0004]).

As per **claim 10**, Jun discloses a method as applied above in claim 9. Jun further discloses wherein the points are as well accumulated and updated with respect to users, who have read advertisements accumulated in ISP managing a system for counting the points from the outside via the internet (e.g. paragraph [0032]).

As per **claims 11-13**, Jun discloses a method as applied above in claim 1. Jun further discloses wherein advertisement data preliminarily received from the advertisement requester and accumulated are distributed to logged-in users (e.g. paragraph [0030]), Jun further discloses wherein a status that advertisement data accumulated by the advertisement requester have been read by the user via the internet (paragraph [0028] and Jun further discloses wherein a status that the user has read advertisements by accessing a system, which is managed by an advertisement distributing dealer ("Vendor Q" – e.g. paragraph [0030]) accumulating and possessing advertisement data concerning advertisements requested by an advertisement requester, via the internet (e.g. paragraph [0030])

Jun is silent on the distribution history such as the number of times and degree of the distribution is accumulated and updated for each advertisement of the advertisement data. However, in the paragraph [0030], Jun discloses "... Various processing programs, such as data, each vender's Q original advertising information, and an information offer processing program for transmitting the predetermined information and the various predetermined messages of goods to Customer P

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according to the demand from a consumer premises equipment 2, are stored in the hard disk store 327".

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made that stored data/information includes distribution history and the updated distribution history. The motivation of doing so would have been "for a customer even if it is outside a metaphor house, it is no charge or an Internet access service can be received cheaply and easily. For a vendor while increasing an opportunity to supply the advertisement of own goods to a customer", as taught by Jun (paragraph [0004]).

As per **claim 14**, Jun discloses a method as applied above in claim 13. Jun further discloses wherein the system, which is managed by an advertisement management dealer accumulating and possessing advertisement data concerning advertisements requested by an advertisement requester (e.g. paragraph [0030]), possesses distribution record data obtained by recording the number of times and degree of advertisement distribution for obtaining a fee corresponding to the number of times and frequency of the advertisement distribution from the advertisement requester (see above rejection in claim 13).

As per **claims 24-26**, they are rejected using the same rationale as for the rejection of claims 8-9 and 11.

As per **claim 27**, it is rejected using the same rationale as for the rejection of claim 11.

As per **claim 28**, it is rejected using the same rationale as for the rejection of claim 11.

As per **claims 29-30**, they are rejected using the same rationale as for the rejections of claims 11-14.

15. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art by Jun (Japanese Patent Laid-open 2001-266018. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office) as applied to claims 1-30 above, and further in view of Applicant's admitted prior art by Kawano (Japanese Patent Laid-open 2001-298484. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office)

As per **claim 31**, Jun discloses a system as applied above in claim 21.

Jun does not disclose expressly comprises a QoS (quality of service) unit for controlling a preset QoS for each user's service class, and the service server has a communication quality managing table, in which communication qualities of services are preset.

Kawano discloses comprises a QoS (quality of service) unit for controlling a preset QoS for each user's service class, and the service server has a communication

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quality managing table, in which communication qualities of services are preset (e.g. abstract, paragraph [0015] and [0039]-[0040]).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate a QoS (quality of service) unit for controlling a preset QoS for each user's service class, and the service server has a communication quality managing table, in which communication qualities of services are preset to Jun's system.

The motivation of doing so would have been for a user "to choose freely the service conditions of a network service to use at every connection and can specify them when connecting with a network from a user terminal and has the effectiveness of becoming possible to offer the network service according to the service condition", as taught by Kawano (paragraph [0039])

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO-892)


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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


10 January 2007
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